

REMARKS

Applicant has carefully reviewed the Office Action mailed February 8, 2007 and offers the following remarks.

Claims 1-16 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,471,519 to Howe et al. (hereinafter “Howe”) in view of U.S. Patent No. 5,768,356 to McKendry et al. (hereinafter “McKendry”). Applicant respectfully traverses. To establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is taught or suggested in the combination of references. MPEP § 2143.03. An obviousness inquiry requires looking at a number of factors, including the background knowledge possessed by a person having ordinary skill in the art, to determine whether there was an apparent reason to combine the elements of the prior art in the fashion claimed by the present invention. *KSR Int’l v. Teleflex, Inc.*, No. 04-1350, slip op. at 14 (U.S., Apr. 30, 2007). For the Patent Office to combine references in an obviousness rejection, the Patent Office must identify a reason why a person of ordinary skill in the art would have combined the references. *Id.* at 15. If the Patent Office cannot establish obviousness, the claims are allowable.

Before addressing the rejections, Applicant provides a brief summary of the claimed invention so that the remarks are considered in the proper context. The present invention is designed to facilitate monitoring of a hosted voicemail system. Meaning, even though the hosted voicemail system is not directly associated with any customer device, the user may listen as voice messages are being left in the voicemail system and may interrupt the message to answer the call. The claims are focused on an embodiment wherein the calls are directed initially to the voicemail system and then the telephone terminal is alerted to the existence of the incoming call that the called party may wish to monitor. The voicemail system of a service provider, according to the present invention, may be configured to provide the functionality of a conventional answering machine. The user may listen to the voicemail message being left by the caller as the voicemail message is being recorded. At any time during the recording of the voicemail message, the user may engage the call and begin conversing with the caller.

Applicant first submits that Howe and McKendry are not properly combined. Howe teaches away from the type of invention disclosed by McKendry. Howe is directed to a method and apparatus for monitoring and controlling communications directed to a called party (Howe, col. 1, lines 6-9). Upon receiving a communication directed to a called party, the invention of

Howe determines the location of the called party and calls the called party at the location (Howe, Abstract; and col. 3, lines 24-47). If the called party picks up the call, then the caller has the option of rejecting the call and routing the call to a message service along with a request to monitor the call (Howe, Abstract, and col. 3, lines 47-64). If the called party does not pick up the call within a predetermined time, the call is routed to the communication service (Howe, col. 3, lines 65-67). Thus, there are two clear teachings in Howe: (1) the call is initially directed to the terminal of the called party, and in fact, the user must answer the call before choosing to monitor the call (Howe, col. 3, lines 47-67; col. 9, lines 44-47; and col.10, lines 28-31); and (2) the invention of Howe is based on knowing the location of the called party (Howe, col. 3, lines 24-34). Because Howe teaches that the call is initially directed to the terminal of the called party, and in fact, the user must answer the call before choosing to monitor the call, Howe teaches away from the present invention, in which the call is initially directed to the hosted voice mail system. MPEP § 2141.02; *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

The teachings of Howe also are in conflict with, and thus teach away from, the invention disclosed in McKendry. McKendry teaches a user programmable personal call manager (PCAM) that selectively routes incoming calls to various locations. Like Howe, the call in McKendry is initially directed to the user. However, McKendry differs from Howe in that McKendry teaches that the PCAM controls the routing of the call and does not require the user to answer the initial call to the terminal in order to monitor the call. In addition, McKendry does not require knowing the location of the party in order to reach the party; in fact, McKendry states that the PCAM eliminates the necessity of knowing the location of a party to reach that party (McKendry, col. 4, lines 39-42). Thus, there are at least two differences between Howe and McKendry that make combining the references improper. See MPEP § 2143.01 (examiner must consider the degree to which one reference discredits another where the teachings of two or more prior art references conflict), *citing In re Young*, 927 F.2d 588 (Fed. Cir. 1991).

First, Howe teaches determining the location of the called party and ringing the called party at the terminal. The invention of Howe actually rings the terminal and only routes the call to a messaging service if the call is not picked up (Howe, Abstract; col. 3, lines 47-67; col. 9, lines 44-47; and col.10, lines 28-31). Howe only allows monitoring if the user answers the initial call. In contrast, McKendry teaches that the call is controlled by the PCAM and the call may be

routed by the PCAM (McKendry, col. 14, lines 1-35). The call may be routed to the voice mailbox after a number of rings and then the PCAM calls a monitor telephone to inform the user of the monitor call (McKendry, col. 14, lines 13-18 and 36-47). McKendry thus teaches monitoring even when the initial call to the terminal is not answered. Thus, this is one example of where the references conflict, and shows that the two references would not be combined by a person of ordinary skill in the art.

Second, the invention of Howe is premised on determining the location of the called party and calling the user at that location (Howe, col. 3, lines 24-34). In contrast, McKendry discloses a method which is directed to routing the call such that the location of the user need not be known (McKendry, col. 4, lines 39-42). Since McKendry eliminates the necessity of knowing the location of a called party to reach the called party, and Howe is premised on determining the location of the called party, this is another example of where the references conflict, and yet another reason why the two references would not be combined by a person of ordinary skill in the art.

Since the teachings of the two references conflict, a person of ordinary skill in the art would not combine the Howe and McKendry references. In addition, even if the combination was attempted, it is apparent that the combination would render one or more of the references unsatisfactory for its intended purpose, or impermissibly change the principle of operation of one or both references. MPEP § 2143.01. At the very least, combining Howe and McKendry would change the principle of operation of Howe and/or make McKendry unsuitable for its intended purpose since McKendry teaches away from determining the location of the called party, which is fundamental to the invention of Howe. Given the conflicts between the teachings of Howe and McKendry, there is no apparent reason why a person of ordinary skill in the art would combine the elements of the prior art in the fashion claimed by the present invention. *KSR Int'l v. Teleflex, Inc.*, No. 04-1350, slip op. at 14 (U.S., Apr. 30, 2007).

Moreover, the rationale given by the Patent Office for combining Howe and McKendry would not provide an apparent reason why a person of ordinary skill in the art would combine the elements of the prior art in the fashion claimed by the present invention. The Patent Office opined that it would have been obvious to one of ordinary skill in the art to combine McKendry with Howe for the purpose of dynamically routing calls depending on the types of calls and circumstances such as monitoring the call at any location (Office Action mailed February 8,

2007, p. 3). However, Howe already discloses a system for routing calls depending on the types of calls and the location of the called party (Howe, Abstract; col. 3, lines 24-67; col. 9, lines 44-47; and col.10, lines 28-31). By doing so, Howe allows the monitoring of the call at any location (Howe, Abstract; and col. 3, lines 24-67). Since Howe already accomplishes the purpose that the Patent Office says would be accomplished by adding McKendry, there would be no apparent reason why a person of ordinary skill in the art would combine the elements of the prior art in the fashion claimed by the present invention. *KSR Int'l v. Teleflex, Inc.*, No. 04-1350, slip op. at 14 (U.S., Apr. 30, 2007). Thus, the combination of Howe and McKendry is improper for this additional reason.

Even if the combination of Howe and McKendry were proper, a point Applicant does not concede, the combination does not teach each and every limitation of the claimed invention. Claim 1 recites that the call is initially directed to the hosted voicemail system before being directed to the telephone terminal. Howe shows the opposite situation (see Howe, Fig. 3A (steps 39 and 40); col. 3, lines 65-67; and col. 9, lines 44-47). The Patent Office admits that Howe does not teach that the call is initially directed to the hosted voicemail system before being directed to the telephone terminal (Office Action mailed February 8, 2007, p. 3). However, the Patent Office asserts that McKendry teaches a system where a call is initially directed to a hosted voicemail system before being directed to the telephone terminal. *Ibid.* Applicant respectfully traverses. McKendry does not teach **initially** directing a call to the hosted voicemail system and then to the telephone terminal.

The Patent Office references McKendry, col. 12, lines 10-21, and col. 14, line 63 through col. 15, line 6 as allegedly teaching that the call is initially directed to the hosted voicemail system before being directed to the telephone terminal (Office Action mailed February 8, 2007, p. 3). McKendry discloses a PCAM located on the user's premises that programmably routes calls both on and off customer premises (McKendry, col. 12, lines 10-21). A user can configure the PCAM to transfer an incoming call to any one of a telephone answering machine on customer premises, a voice mailbox in a personal computer on the customer premises, or a voice mailbox at a central office after a predetermined number of rings (McKendry, col. 14, lines 13-18). The PCAM retains control over the calls even after the call is answered by an answering machine or a user (McKendry, col. 14, lines 29-33). The user can configure the PCAM so that a telephone on the customer premises, a remote phone, or a cellular phone is a monitor telephone.

In response to an incoming call, the PCAM calls the monitor phone and establishes a one-way connection with the incoming call, while simultaneously ringing the answering machine on the customer premises or remote telephone instruments (McKendry, col. 14, lines 36-44). When the user answers the monitor telephone, the PCAM informs the user of the monitor call and the user can either hang-up, or take the monitor call so that when the answering machine takes the call, the user can listen to the message being left (McKendry, col. 14, lines 45-50).

However, the key difference between McKendry and the present invention is that the call in McKendry is still initially directed to the terminal of the called party (see McKendry, Figure 1; and col. 14, lines 1-18). McKendry discusses call forwarding by the PCAM (McKendry, col. 14, lines 4-12). The PCAM transfers the incoming call to various places, including the voice mailbox at the central office (McKendry, col. 14, lines 13-18). It is clear from an examination of McKendry, Figure 1 and col. 14, lines 1-18, that the call is initially directed to the called party and the PCAM intercepts the call and forwards or transfers the call. In fact, col. 14, lines 13-18 of McKendry states that the PCAM transfers the incoming call to any one of a number of places **after a predetermined number of rings** (emphasis added). Therefore, McKendry discloses that the call is initially directed to a terminal of the user and is not initially directed to the hosted voicemail system before being directed to the telephone terminal, as recited in claim 1.

From the above discussion, it is clear that the combination of Howe and McKendry fails to teach or suggest “wherein the call is initially directed to the hosted voicemail system before being directed to the telephone terminal,” as recited in claim 1. Since the combination does not teach or suggest initially directing a call to a hosted voicemail system to facilitate audible call screening in association with a hosted voicemail system, *prima facie* obviousness has not been established. As such, claims 1-19 and 21-33 define patentable subject matter.

Claims 17-19 and 21-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Howe in view of McKendry and further in view of U.S. Patent Application Publication No. 2004/0096046 A1 to Lektion et al. (hereinafter “Lektion”). Applicant respectfully traverses. The standards for obviousness are set forth above.

The Patent Office has offered no new arguments with respect to claim 17 other than the addition of McKendry. As set forth above, the combination of Howe and McKendry is not proper, and therefore the combination of Lektion with Howe and McKendry is also improper. Also as discussed above, the combination of Howe and McKendry does not teach each and every

limitation of the claimed invention. Lektion does not cure the deficiencies of the combination of Howe and McKendry. Thus, Applicant respectfully submits that this rejection is improper and should be withdrawn for the reasons set forth above, as well as the same reasons previously set forth by Applicant (see Response filed November 3, 2005; Response filed March 10, 2006; and the Request for Continued Examination/ Response to the Advisory Action filed April 12, 2006). As such, claim 17, as well as claims 18, 19, and 21-32, which depend from claim 17, define patentable subject matter.

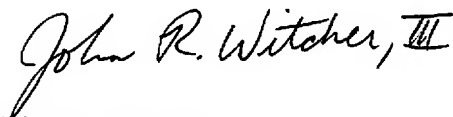
In addition, claims 18, 19, and 21-32 were rejected for the same reasons set forth for claims 2, 3, and 5-16, respectively (see Office Action mailed February 8, 2007, p. 11). Since claims 2, 3, and 5-16 were rejected over Howe in view of McKendry, the Patent Office is using McKendry to reject claims 18, 19, and 21-32 as well. As set forth above, the combination of Howe and McKendry does not teach each and every limitation of the claimed invention. For at least the same reasons, the rejection of claims 18, 19, and 21-32 is improper as well.

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicant's representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By:



John R. Witcher, III
Registration No. 39,877
100 Regency Forest Drive, Suite 160
Cary, NC 27518
Telephone: (919) 238-2300

Date: May 8, 2007

Attorney Docket: 7000-262